

Appl No. 10/715,957
Response Date: 12/05/2005
Response to Office Action

REMARKS/ARGUMENTS

Applicant respectfully requests reconsideration and withdrawal of the rejections in the September 8, 2005 Office Action based on the following remarks.

Pending Claims

Claims 1-13 are pending in the application. Of these claims, Claims 1, 10, 11, 12, and 13 are independent claims and the remaining claims are dependent claims.

Summary of Rejections

Claims 1, 2 & 4-13 were rejected under 35 U.S.C. 102(b) as being anticipated in view of Silverbrook et al. (US PG PUB 2002/0080396).

Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. (US PG PUB 2002/0080396) in view of Tan et al. (US 6,613,403).

Traversal of Rejection under 35 U.S.C. 102(b)

Applicant respectfully traverses the rejection of Claims 1, 2, & 4-13 under 35 U.S.C. 102(b) as being anticipated in view of Silverbrook et al. (US PG PUB 2002/0080396) [hereinafter "Silverbrook"].

Turning to the specific claim language of the present application, independent Claim 1 is directed to a recording apparatus for forming an image on a recording medium comprising recording means for performing recording by applying a recording material onto the recording medium, the recording means recording at least one of a positional information image representing positional information corresponding to the position

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where the positional information image is recorded and the other image, and a control means for controlling the recording such that the recording means records the positional information image with a recording material capable of being detected by a predetermined detector, and said other image with another recording material incapable of being detected by the detector.

The present invention of independent Claim 1 describes recording, on a recording medium, image data and positional information image data, where the positional information image data represents positional information corresponding to the position where the positional image data is recorded.

Applicant respectfully submits that Silverbrook fails to disclose at least the above-noted features of the present invention.

Silverbrook is seen to describe a system for producing interface surfaces ("netpages") which allow users to interact with networked information and to obtain interactive printed matter. More specifically, a "netpage" consists of a printed page (or other surface region) invisibly tagged with references to an online description of the page. The tags may be printed on or into the surface of the page, may be in or on a sub-layer of the page or may be otherwise incorporated into the page. The online page description is maintained persistently by a netpage page server. The page description describes the visible layout and content of the page, including text, graphics and images. It also describes the input elements on the page, including buttons, hyperlinks, and input fields. A netpage allows markings made with a netpage pen on its surface to be simultaneously captured and processed by the netpage system (paragraph 0148).

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Tags are printed in infrared-absorptive ink on any substrate which is infrared-reflective, such as ordinary paper (paragraph 0151). A tag is sensed by an area image sensor in the netpage pen, decoded and the data encoded by the tag is transmitted to the netpage system, preferably via the nearest netpage printer. Tags are sufficiently small and densely arranged that the pen can reliably image at least one tag even on a single click on the page. It is important that the pen recognize the tag and extract the page ID and position on every interaction with the page, since the interaction is stateless. Tags are error-correctably encoded to make them partially tolerant to surface damage (paragraph 0152).

In a preferred form, each tag identifies the region in which it appears, and the location of that tag within the region. A tag may also contain flags which relate to the region as a whole or to the tag. One or more flag bits may, for example, signal a tag sensing device to provide feedback indicative of a function associated with the immediate area of the tag, without the sensing device having to refer to a description of the region. A netpage pen may, for example, illuminate an "active area" LED when in the zone of a hyperlink (paragraph 0155).

As the above referenced sections of Silverbrook illustrate, Silverbrook discloses the structure to detect a tag, printed on a recording medium with invisible ink, by a sensor on a pen. The position on the surface of the recording medium can be determined by reading the tag using the pen.

The disclosed tag comprises at least 90 bits of region ID (paragraph 0158), which itself shows the position on the recording medium. In other words, encoded information showing the position on the recording medium is already included in the tag.

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Nothing in Silverbrook is seen to disclose or describe recording a positional information image. As indicated above, each of the tags of Silverbrook contains tag ID information, which can include the position of the tag (e.g., the region on the surface in which the tag appears and the location of the tag within the region). Recording a tag, where the tag contains information regarding the tag's position is not seen to describe recording a positional information image as described in the present invention.

Because Silverbrook lacks at least the above-noted features of the present invention, Applicant submits that Silverbrook fails to disclose each and every feature recited in Claim 1, and that the Office Action fails to include adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. 102(b). Therefore, Applicant submits that the rejection of at least Independent Claim 1 is improper and respectfully requests that the rejection be withdrawn.

Furthermore, Applicant submits that Claims 2, and 4-9 are allowable at least for the reason that these claims depend from allowable base Claim 1 and recite additional features that further define the present invention.

In addition, Independent Claims 10, 11, 12, and 13 were rejected essentially for the same reasons as Independent Claim 1. Thus, Independent Claims 10, 11, 12, and 13 are believed allowable for the same reasons as set forth in the discussion above.

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Traversal of Rejection under 35 U.S.C. 103(a)

Applicant respectfully traverses the rejection of Claim 3 under 35 U.S.C. 103(a) as being unpatentable over Silverbrook in view of Tan et al. (US 6,613,403) [hereinafter "Tan"].

As discussed above, Independent Claim 1 is directed to a recording apparatus for forming an image on a recording medium comprising recording means for performing recording by applying a recording material onto the recording medium, the recording means recording at least one of a positional information image representing positional information corresponding to the position where the positional information image is recorded and the other image, and a control means for controlling the recording such that the recording means records the positional information image with a recording material capable of being detected by a predetermined detector, and said other image with another recording material incapable of being detected by the detector.

Applicant respectfully submits that Silverbrook fails to disclose at least the above-described features of the present invention.

As is noted above, Silverbrook fails to disclose or even suggest these particular features of Claim 1. It is further noted that the aforementioned features are not taught or suggested in Tan either. Therefore, since neither Silverbrook nor Tan discloses or suggests these aforementioned features of the present invention, no proper combination of these documents can render unpatentable the asserted combination of features recited in at least Independent Claim 1.

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Furthermore, Applicant submits that Claim 3 is allowable at least for the reason that it depends from allowable base Claim 1 and recites additional features that further define the present invention.

Accordingly, Applicant respectfully requests the Examiner reconsider and withdraw the rejection of Claim 3 under 35 U.S.C. 103(a) as being unpatentable over Silverbrook in view of Tan, and indicate that this claim is allowable over the art of record.

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CONCLUSION

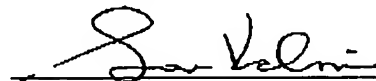
Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability, and respectfully requests the Examiner to indicate the allowance of such claims as the Examiner's earliest convenience.

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention as recited in Claims 1-13. The applied references have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein is respectfully requested and now believed to be appropriate.

Applicants' undersigned attorney may be reached at (949) 932-3329. All correspondences should be directed to the below-listed address.

Respectfully submitted,



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